

### REMARKS

This amendment is submitted in response to the non-final Office Action mailed December 28, 2006. Following entry of this amendment, claims 1-25 and 27-34 remain pending in the application. Claims 1, 23 and 34 are independent. In the Office Action, the Examiner:

- rejected claims 1-17 and 19-33 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 56,406,477 to Fujiwara (hereinafter "Fujiwara"); and
- allowed claim 34 and indicated that claim 18 would be allowable if rewritten in independent form.

Applicants have amended claims 1, 2, 7, 9, and 23 to better define the claimed invention, more clearly distinguish over the cited prior art, and/or conform with amendments to other claims. Claim 26 has been canceled. Paragraph [0055] of the specification has been amended to correct a typographical error in the spelling of the word "grooves." All amendments are fully supported by the originally-filed specification and/or drawings of the present application. No new matter has been added. The claim amendments made herein do not represent acquiescence in the Examiner's rejections, but rather are made only to expedite prosecution of the present application and/or maintain consistency in claim language. Applicants expressly reserve the right to pursue the subject matter of any previously presented claims in one or more continuation applications. As discussed more fully below, Applicants respectfully submit that each of the currently pending claims define features that are not disclosed, taught or suggested by the prior art of record and respectfully request allowance of same.

### *Substance of April 25, 2007 Telephonic Interview*

Applicants wish to thank the Examiner for the courtesy of participating in the telephonic interview with Applicants' representative Thomas Scully on April 25, 2007. During the interview, the cited Fujiwara reference and outstanding claim rejections were discussed and Applicants' representative presented proposed amendments to claim 1 to more clearly distinguish over Fujiwara. More particularly, Applicants' representative pointed out that Fujiwara does *not* disclose a device including a prong that, when *fully engaged* with a

surface of a second implant, prevents rotation of the second implant with respect to a first implant while simultaneously permitting sliding of the second implant with respect to the first implant along the longitudinal axis. As disclosed throughout Fujiwara, spacer 46 “transmit[s] a clamping force from the set screw to the bone connector thereby to *clamp* the bone connector.” (Fujiwara at col. 2, lines 24-26.) The spacer 46 of Fujiwara clearly does *not* permit sliding of a second implant with respect to a first implant along the longitudinal axis of the second implant when the spacer 46 is fully engaged with a surface of the second implant. Applicants have incorporated the substance of the proposed amendments discussed during the interview into this response. The Examiner indicated that Applicants’ proposed amendments may require additional searching.

**Claim Rejections - 35 U.S.C. § 102(e)**

Claims 1-17 and 19-33 were rejected as anticipated by Fujiwara. Applicants respectfully traverse these claim rejections and, for the reasons discussed below, submit that Fujiwara does not disclose, teach or suggest each of the limitations recited in amended independent claims 1 and 23.

As amended, independent claim 1 recites a bone fixation system for coupling a first fracture fixation implant to a second fracture fixation implant defining a longitudinal axis, comprising, *inter alia*, “a body member including at least one prong extending from the body member for contacting a surface of the second implant, the at least one prong permitting rotation of the second implant with respect to the first implant when in a first position within the first implant and preventing rotation of the second implant with respect to the first implant while simultaneously permitting sliding of the second implant with respect to the first implant along the longitudinal axis when in a second position fully-engaged with the surface of the second implant.” Support for this amendment is found in the originally-filed specification of the present application, as shown below:

When implant 20 is received in bore 66 in intramedullary nail 22 and body member 60 is located in channel 64 with tabs 85 bottomed out on ends 67 of grooves 65, prong 76 interacts with implant 20 to substantially prevent rotation of implant 20 about its longitudinal axis 30. More specifically, prong 76 fits tightly in the space between channel 64 and implant 20 such that first and second engagement surfaces 86, 90 are maintained in contact under the constraints of channel 64. In this configuration, implant 20 is substantially prevented from rotation about its longitudinal axis 30 due to abutment of substantially flat first and second engagement surfaces 86, 90. . . .[F]irst and second stops 92, 94 may be selectively spaced apart along longitudinal axis 30

to provide for a desirable amount of sliding between implant 20 and intramedullary nail 22, such as to provide for compression between the two fractured bone fragments.

(Specification at Para. [0055]; *see also* Para. [0047].) Claim 23 has been similarly amended.

Applicants respectfully submit that these amendments clarify that the claimed device includes a prong that, when *fully-engaged* with the surface of the second implant, prevents rotation of the second implant with respect to the first implant, while *simultaneously* permitting sliding of the second implant with respect to the first implant.

Fujiwara does *not* disclose a device including a prong that, when *fully-engaged* with a second implant, prevents rotation of the second implant with respect to a first implant, while simultaneously permitting sliding of the second implant with respect to the first implant, as recited in independent claim 1. Fujiwara discloses an intramedullary nail and lag screw assembly including a spacer 46 that, when fully-engaged, prevents *both* sliding and rotation of the lag screw with respect to the nail:

[T]he set screw 42 pushes down the whole of the spacer 46 and the lower ends of the legs 46b come into engagement with the grooves 34 of the lag screw 22, thereby securing the lag screw 22 in the nail member 16 while at the same time preventing the rotation of the lag screw 22. Even in the case where the grooves 34 are not formed on the periphery surface of the lag screw 22, the lag screw 22 can be secured in the nail member 16 by being clamped between the nail member 16 (particularly the surface of the main through hole 24) and the spacer 46 due to the friction between the lower ends of the legs 46b of the spacer 46 and the peripheral surface of the lag screw 22.

(Fujiwara at col. 5, lines 20-33 (emphasis added).) Therefore, Fujiwara fails to disclose a device having the claimed “at least one prong extending from the body member for contacting a surface of the second implant, the at least one prong permitting rotation of the second implant with respect to the first implant when in a first position within the first implant and preventing rotation of the second implant with respect to the first implant while simultaneously permitting sliding of the second implant with respect to the first implant along the longitudinal axis when in a second position fully-engaged with the surface of the second implant,” as recited in amended claim 1. Similarly, Fujiwara fails to disclose a device having first and second prongs, “wherein the prongs permit rotation of the second implant with respect to the first implant when the prongs are in a first position within the first implant and at least one of the prongs prevents rotation of the second implant with respect to the first implant while simultaneously permitting sliding of the second implant with respect to the first

implant along the second longitudinal axis when in a second position fully-engaged with the second implant,” as recited in independent claim 23.

Accordingly, since Fujiwara fails to disclose, teach or suggest all of the elements recited in amended claims 1 and 23, Applicants respectfully request that the anticipation rejection of claims 1 and 23 be withdrawn and that these claims, and each of their dependent claims 2-22, 24-25 and 27-33, be allowed.

**Allowable Subject Matter**


The Office Action indicates that claim 34 is allowable and that claim 18 is objected to as being dependent upon a rejected base claim, but otherwise allowable if rewritten in independent form. Applicants wish to thank the Examiner for this indication of allowable subject matter.

In view of the above, Applicants respectfully submit that, in addition to previously allowed claim 34, claims 1-25 and 27-33 are now in condition for allowance. The Examiner is invited to call the undersigned attorney at (212) 326-3939 if a telephone call could help resolve any remaining issues.

A separate petition for extension of time is submitted herewith. No additional claim fees are believed due with this submission. However, should any additional fees be required, please charge such fees to Jones Day deposit account no. 50-3013.

Respectfully submitted,

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